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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,298	06/27/2001	Paul England	MSFT-0279/148585	2350

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EXAMINER

PICH, PONNOREAY

ART UNIT PAPER NUMBER

2135

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/892,298	Applicant(s) ENGLAND ET AL.	
	Examiner Ponnoreay Pich	Art Unit 2135	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s) ~~a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.~~
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 2-5, 7-10, 13-15, 17, 19-22, 24-27, 30-32, and 34.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Applicant only presented arguments. No amendments were filed.

Response to Arguments

Applicant's arguments filed 10/11/2005 have been fully considered but they are not persuasive.

On page 3, paragraph 2, applicant argues that the examiner's assumption that the lack of comment with regard to certain statements of well-known prior art, i.e. official notice, is taken as agreement on the part of applicant with such statement as incorrect. Applicant argues that applicant responding to the first office action with amendments is an implicit traversal of any statement on what may or may not be well-known prior arts. The examiner respectfully directs applicant to MPEP 2144.03, section C: "To adequately traverse such a finding, an applicant must **specifically** point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.... **If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate**, the examiner should clearly indicate in the next Office action that **the common knowledge or well-known in the art statement is taken to be admitted prior art** because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate." As cited from the MPEP, well-known art statements must be **specifically** traversed by applicant. Applicant did not specifically argue any well-known in the art statement and the

examiner merely followed procedures as required by the MPEP and pointed out that because applicant did not specifically traverse, those statements are taken to be admittance of prior art. Applicant states that the amendments were an implicit traversal, but an implicit traversal is not a specific traversal. Applicant may have wanted to avoid unnecessarily creating file wrapper estoppel, but the examiner respectfully submits that clearly and specifically pointing out any well-known art statements that applicant disagreed with would have been more valuable in efficiently forwarding prosecution of this current application on merits. Any prior art statements that applicant did not argue in the prior office actions remains considered as admitted prior art.

Applicant argues that Van Dyke does not disclose a video memory in a video section should be write-only except with regards to the video section, and with regards to rights-protected content allowed to be rendered by a DRM system. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The rejection of this limitation was obviously based on the combination of SDMI and Van Dyke, not Van Dyke alone.

Applicant argues that the only justification offered by the examiner for combining Van Dyke restricted access with SDMI device is that by restring access to the memory, one is also restricting access to any content stored in the memory." Applicant argues that this is hindsight justification as neither Van Dyke nor SDMI teaches the need for restricting access to DRM-controlled digital video content in a video memory. Applicant

is directed to the last paragraph on page 6 of the final office action where the examiner also stated that the motivation to incorporate Van Dyke's teachings was that "it would allow for content providers to have better control over their digital content including the legal distribution of their digital content, which was a goal disclosed by SDMI (p30, section 10.1.1.1 and 10.1.3). Applicant is also reminded that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that the limitation of "an authentication device for authenticating to the DRM system that the video memory is configured to be write-only except with regard to the video section" would not be obvious based on the Shear reference teaching of use of an authenticated device such as digital signature for authenticating that a module performs as intended because Shear's authentication device is employed only with software modules and not hardware modules and particularly not with any video section module or memory thereof. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The

limitation in question was stated as obvious over the teachings of SDMI, Van Dyke, and Shear, not just Shear alone.

Applicant argues that the justification that the examiner offered to combine Shear, with Van Dyke, and SDMI is hindsight because the only justification was "that it would allow for content providers to have better control over their digital content including legal distribution thereof...". The examiner respectfully point out that this was not the motivation given by the examiner for incorporating Shear. Applicant is directed towards the final office action, page 6, last two lines and page 7, first two lines where the motivation given for incorporating Shear was "it would provide content providers better assurance that the device rendering their content in fact is as secure as it is supposed to be." Further, in response to applicant's argument that the present invention is not primarily concerned with legal distribution of content, but instead with protecting such content as it is being rendered and momentarily in unprotected form, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant's remaining arguments are directed towards dependent claims being allowable because the independent claims should be allowed. As applicant's arguments for the independent claims have been traversed, the remaining arguments are moot.


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